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Barry E. Bretschneider Morrison & Foerster LLP 2000 Pennsylvania Ave., N.W. Washington, DC 20006-1888			STRANGE, AARON N	
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* YASUSHI YAMADE

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Appeal 2008-004582  
Application 10/073,150  
Technology Center 2400

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Decided:<sup>1</sup> May 26, 2009

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Before JEAN R. HOMERE, ST. JOHN COURTENAY III,  
and STEPHEN C. SIU, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 CFR § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

#### STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-11. Claim 12 is canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

#### *Invention*

Appellant's invention generally relates to a data transmission device that increases efficiency in data transmission during multi-destination delivery. (See Spec. 1-2, Para. [0002], [0008]).

#### *Representative Claim*

1. A data transmission device comprising:

transmitting means having a first transmission mode in which a file is sent attached to an e-mail message, a second transmission mode in which a file is sent to a file transfer server, and a mixed transmission mode in which a file is sent to a file transfer server and an e-mail message having a text string including address information of the file transfer server is sent; and

transmission judging means for determining whether or not the destinations include those for which the first transmission mode as well as those for which the second transmission mode are designated during multi-destination delivery in which multiple destinations are designated, wherein

when the transmission judging means judges that the destinations for the first and second transmission modes are included, the transmitting unit executes the mixed transmission mode in which an e-mail message having a text string including

address information of the file transfer server designated in the second mode is sent to the destination designated for the first mode, where no file is attached to the e-mail, and

a file designated to the second mode is sent to the file transfer server.

*Prior Art*

The Examiner relies on the following references:

Ramaley	US 6,687,741 B1	Feb. 3, 2004
Kakimoto	US 6,775,688 B1	Aug. 10, 2004

*Examiner's Rejection*

Claims 1-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kakimoto in view of Ramaley.

**FINDINGS OF FACT**

In our analysis *infra*, we rely on the following findings of fact (FF) that are supported by a preponderance of the evidence:

1. Ramaley teaches determining whether to send a file as a link, an attachment, or as a link and an attachment. (Col. 7, ll. 30-36; Fig. 3).
2. Ramaley teaches that a determination is made as to whether a file has been saved. If the file is not stored in a shared disk location, the file is sent as an attachment. Otherwise, a registry setting that corresponds to a “send preference” is checked and the file is either sent only as a link or as both links and attachments. (Col. 7, ll. 38-40 and col. 8, ll. 7-8; Fig. 3).

## ISSUE

Based upon our review of the administrative record, we have determined that the following issue is dispositive in this appeal:

Has Appellant shown the Examiner erred in finding that Ramaley teaches or suggests the limitation of “determining whether or not the destinations include those for which the first transmission mode as well as those for which the second transmission mode are designated during multi-destination delivery in which multiple destinations are designated?”

## PRINCIPLES OF LAW

“What matters is the objective reach of the claim. If the claim extends to what is obvious, it is invalid under § 103.” *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 419 (2007). What a reference teaches is a question of fact. *In re Baird*, 16 F.3d 380, 382 (Fed. Cir. 1994); *In re Beattie*, 974 F.2d 1309, 1311 (Fed. Cir. 1992).

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner’s position. See *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006). Therefore, we look to Appellant’s Briefs to show error in the Examiner’s proffered prima facie case.

## ANALYSIS

As noted above, Appellant contends that the cited references, most notably Ramaley, fail to teach “determining whether or not the destinations

include those for which the first transmission mode as well as those for which the second transmission mode are designated during multi-destination delivery in which multiple destinations are designated,” as recited in independent claims 1, 6, and 9. Appellant further contends that Ramaley does not teach or suggest multi-destination delivery but rather determines the way in which a file is to be delivered, either by sender preference or by default, depending on whether the file is in a shared disk location. (App. Br. 7). The Examiner contends that this limitation is taught by Ramaley. (Ans. 4-5)

At the outset, we interpret the independent claims to require that the mixed transmission mode of delivery replaces the first transmission mode after the determination is made that the multi-destination delivery (in which multiple destinations are designated) includes both the first and second transmission modes.

Ramaley teaches determining whether to send a file as a link, an attachment, or as a link and an attachment. (FF 1). As noted above, Ramaley determines the mode of delivery based on the sender’s preference, or by default. (FF 1-2). Therefore, we find that Ramaley does not teach or fairly suggest sending a file based upon “whether or not the destinations include those for which the first transmission mode as well as those for which the second transmission mode are designated during multi-destination delivery in which multiple destinations are designated,” as claimed. (independent claim 1; *see* equivalent language in each of independent claims 6 and 9).

In addition, we have not found, nor has the Examiner established, that Kakimoto cures the deficiencies of Ramaley. Accordingly, we reverse the Examiner's rejection of independent claims 1, 6, and 9 and associated dependent claims 2-5, 7-8, and 10-11.

#### **CONCLUSION**

Appellant has established the Examiner erred in finding that the combination of Kakimoto and Ramaley teaches determining whether or not the destinations include those for which the first transmission mode as well as those for which the second transmission mode are designated during multi-destination delivery in which multiple destinations are designated.

**DECISION**

We reverse the Examiner's rejection of claims 1-11 under 35 U.S.C. § 103(a).

**REVERSED**

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